



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/765,985	01/19/2001	Michael A. Sharp	8247-82809-01	1204
24197 7590 05/14/2010 KLARQUIST SPARKMAN, LLP 121 SW SALMON STREET SUITE 1600 PORTLAND, OR 97204				
EXAMINER				
MITTAL, KRISHAN K				
ART UNIT		PAPER NUMBER		
3688				
MAIL DATE		DELIVERY MODE		
05/14/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

*Ex parte* MICHAEL A. SHARP

---

Appeal 2009-010968  
Application 09/765,985  
Technology Center 3600

---

Decided: May 14, 2010

---

Before HUBERT C. LORIN, ANTON W. FETTING, and  
BIBHU R. MOHANTY, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

An oral hearing was held on March 17, 2010.

## STATEMENT OF THE CASE

Michael A. Sharp (Appellant) seeks our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 14-37. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

## SUMMARY OF DECISION

We AFFIRM-IN-PART but denominate the affirmed rejection of claims 14-34 as NEW GROUNDS OF REJECTION pursuant to our authority under 37 C.F.R. § 41.50(b).<sup>1</sup>

## THE INVENTION

The invention relates to “distribution of advertising via computer networks.” Specification 1:11.

Claim 14, reproduced below, is illustrative of the subject matter on appeal.

14. A distribution system that comprises:
  - at least one network server that provides a web site having audio files available for download by web site visitors,
  - wherein one or more of the audio files includes an embedded audio message from a sponsor.

---

<sup>1</sup> Our decision will make reference to the Appellant’s Appeal Brief (“App. Br.,” filed Oct. 14, 2008) and Reply Brief (“Reply Br.,” filed Mar. 9, 2009), and the Examiner’s Answer (“Answer,” mailed Jan. 9, 2009).

### THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Wolfe                                      US 5,931,901                                      Aug. 3, 1999

The following rejection is before us for review:

1. Claims 14-37 are rejected under 35 U.S.C. §103(a) as being unpatentable over Wolfe.

### ISSUES

The principle issue is whether the use of the term “download” in the claims renders the subject matter claimed nonobvious over Wolfe’s “streaming.”

### FINDINGS OF FACT

We find that the following enumerated findings of fact (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

#### *Claim construction*

1. The claims use the term “download.”
2. The Specification does not provide a definition for “download”
3. According to a general dictionary, the definition of “download” is “to transfer (as data or files) from a usually large computer to the memory of another device (as a smaller computer).” (*See Merriam-Webster’s*

online Dictionary, 1979. (<http://www.merriam-webster.com/dictionary/download>.) (Entry for “download.”).

4. According to a more technical dictionary, the definition of “download” is “to transfer a file from another computer to your computer by means of a modem and a telephone line.” (See Webster’s New World Dictionary of Computer Terms, p. 174 (8th Ed. 2000).) (Entry for “download.”) .

*The scope and content of the prior art*

5. Wolfe relates to a “stream” of data.

*Any differences between the claimed subject matter and the prior art*

6. The claims use the term “download” and Wolfe uses the term “stream”.

*The level of skill in the art*

7. Neither the Examiner nor the Appellant has addressed the level of ordinary skill in the pertinent art of transferring data or files. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. See *Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’”) (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).

*Secondary considerations*

8. A Declaration of Rod Underhill, dated February 15, 2008, has been submitted as evidence of secondary considerations of non-obviousness for our consideration.

PRINCIPLES OF LAW

*Claim Construction*

During examination of a patent application, a pending claim is given the broadest reasonable construction consistent with the specification and should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1369 (Fed. Cir. 2004).

[W]e look to the specification to see if it provides a definition for claim terms, but otherwise apply a broad interpretation. As this court has discussed, this methodology produces claims with only justifiable breadth. *In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984). Further, as applicants may amend claims to narrow their scope, a broad construction during prosecution creates no unfairness to the applicant or patentee. *Am. Acad.*, 367 F.3d at 1364.

*In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007). Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003).

*Obviousness*

Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at

the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’

*KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” *Graham*, 383 U.S. at 17-18.

## ANALYSIS

### *Claims 14, 15, and 17-23*

The Appellant argued claims 14, 15, and 17-23 as a group (App. Br. 8-12 and Reply Br. 1-3). We select claim 14 as the representative claim for this group, and the remaining claims 15 and 17-23 stand or fall with claim 14.

Claim 14 is drawn to a system comprising a network server having the capability of providing a web site having audio files “available for download by web site visitors”, wherein one or more of the audio files include an embedded audio message from a sponsor.

Wolfe discloses a system comprising a network server having the capability of providing a web site having audio files, wherein one or more of

the audio files includes an embedded audio message from a sponsor, is not disputed.

The dispute is over whether Wolfe shows a web site having audio files “available for download by web site visitors”.

Appellant takes the position that Wolfe discloses an entirely different technique for delivering content than what is claimed. According to Appellant, the subject matter claimed requires audio files available for *download* while Wolfe provides audio files available only for *streaming*.

According to Appellant, one of ordinary skill in the art given Wolfe’s system for providing streaming audio files would not be led to a system where audio files are provided for download as claimed because one of ordinary skill in the art would know that downloading and streaming are independent and distinct techniques for delivering content. “Despite the examiner’s assertions, Wolfe fails to teach or suggest “a web site having audio files available for download by web visitors as recited by the claim. Wolfe discloses only the delivery or program content and advertising using a streaming technique, and does *not* teach delivery by download. Downloaded data is stored, whereas streamed data is not.” App. Br. 9-10. Emphasis original.

Appellant’s position is premised on (a) the claim term “download” being reasonably broadly construed to include the ability of the delivered downloaded content to be stored for a significant amount of time and (b) Wolfe disclosing a streaming delivery technique that does not allow the delivered streamed content to be stored for any significant amount of time.



The Examiner has not questioned the first premise, appearing to have agreed with Appellant that the claim term “download” is reasonably broadly construed to include the ability of the delivered downloaded content to be stored for a significant amount of time. Instead, the Examiner departs from Appellant as to the second premise, finding that the streaming delivery technique that Wolfe discloses does allow the delivered streamed content to be stored for a significant amount of time.

While Wolfe does not explicitly disclose that the combined file being downloaded is stored on the user device, the disclosure that the user may attempt to disseminate the file at least implies that it has been or could be stored on the user device. By discussing how the security measures can prevent the user from being able to copy and disseminate the files. Wolfe is explicitly teaching that without the security procedures a user could copy and disseminate the file. Thus, the system designer is given two options: either allowing the user to copy and disseminate the file or using encryption to prevent the user from doing so.

Answer 3. The Examiner also took Official Notice “that it was old and well known at the time of the invention that any incoming data file can be locally stored, either on the receiving device’s hard drive or on any one or more types of removable storage devices . . . .” Answer 3-4. Appellant disputes that Wolfe suggests that its stream-able files can be stored or that one of ordinary skill would be led to do so, even if known.

The fundamental, real-time nature of Wolfe’s system would be altered in undesirable ways if one attempted to substitute the download technique [*i.e.*, the ability of the delivered downloaded content to be stored for a significant amount of time] for the streaming technique [*i.e.*, a streaming delivery technique that does not allow the delivered streamed content to be stored for any significant amount of time].

App. Br. 11.

Our difficulty lies with the first premise - that the claim term “download” should be construed narrowly to only mean having the ability of the delivered downloaded content to be stored for a significant amount of time. We are not persuaded that the evidence currently on record adequately supports this narrow construction.

[T]he PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification. In re Morris, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

That means claim terms “are generally given their ordinary and customary meaning.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (quoting *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996)). The “ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, *i.e.*, as of the effective filing date of the patent application.” *Phillips*, 415 F.3d. at 1313.

While “claims themselves [can] provide substantial guidance as to the meaning of particular claim terms,” *Phillips*, 415 F.3d at 1314, here claim 14 provides no additional guidance. Claim 14 simply states: “a web site having audio files available for download by web site visitors.” The claim uses the term “download” plainly without further elaboration or in a context that would change or further limit its ordinary and customary meaning.

Turning to the Specification, that too provides no additional guidance. Claims “must be read in view of the specification, of which they are a part.”

*Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995) (en banc), aff'd, 517 U.S. 370 (1996). A patent's specification "is always highly relevant to the claim construction analysis." *Phillips*, 415 F.3d at 1315). When consulting the specification to clarify the meaning of claim terms, limitations may not be imported into the claims from the specification. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003). But here there is no danger of importing limitations into the claim because there is nothing in the Specification that one can point to (and Appellant does not in fact do so) as a basis for arguing that the claim term "download" has a meaning any different from its ordinary and customary meaning. The Specification uses the term "download" plainly without further elaboration or discussion that would change or further limit its ordinary and customary meaning. The Specification provides no special definition for "download." Nor does it discuss the process of downloading. The Specification uses the term "download" broadly and only in conjunction with the delivery or distribution of content. This is an example: "Before a song is made available for public distribution (download) via the Internet, the song is combined with an advertisement, to form a single audio file." Specification 5:17-18. Accordingly, the Specification cannot be said to lead a person of ordinary skill in the art in question at the time of the invention to *necessarily* understand the term "download" to only mean having the ability of the delivered downloaded content to be stored for a significant amount of time but rather it supports the view that a person of ordinary skill in the art in question at the time of the invention would give the claim term "download" its ordinary and customary meaning.

In this circumstance where neither the claim language nor the Specification provide any further guidance as to the meaning of the claim term “download,” the meaning to be given the term “download” is its ordinary and customary meaning to a person of ordinary skill in the art in question at the time of the invention. In ascertaining a claim term’s ordinary and customary meaning, it is appropriate to refer to a dictionary. Courts may “rely on dictionary definitions when construing claim terms, so long as the dictionary definition does not contradict any definition found in or ascertained by a reading of the patent documents.” *Phillips*, 415 F.3d at 1322–23. In that regard, the dictionaries are consistent in defining “download” as transferring a file from one computer to another. FF 3-4. The definition of “download” as transferring a file or data from one computer to another is consistent with the use of the term “download” in the Specification which, as we have explained, uses the term “download” broadly and in conjunction with the delivery or distribution of content.

Appellant urges a more narrow meaning for the claim term “download” directed to a delivery technique in which the delivered content is characterized by having the capability to be stored locally for a significant amount of time.<sup>2</sup> Appellant contends that this “storing” characteristic is what

---

<sup>2</sup> In support thereof, Appellant relies on the declaration of David Austerberry (dated Jun. 13, 2008). However, this Declaration was filed with the Appeal Brief and does not meet any of the criteria for admission into the record under Rules 41.33(d)(1) and (2). Accordingly, this Declaration will not be considered.

distinguishes “download” as claimed from Wolfe’s streaming technique.  
App. Br. 11.

We are not persuaded that the record supports the Appellant’s position.

As we have explained, the claim language and the Specification use the term “download” broadly. In the case of the Specification, the term “download” is used in conjunction with content delivery and distribution. We are of the view that the Specification would lead one of ordinary skill in the art at the time of the invention to give the term “download” a meaning with a scope commensurate with delivering and distributing content. The definition Appellant would have us apply would narrow the scope of the meaning of “download” such that it includes a storing operation, and not just any storing but one that would allow the content to be stored for a significant amount of time. However, no discussion or suggestion of subsequent storing of the downloaded content is present in the Specification. In our view, the broad meaning given in the dictionaries comports more closely to the way the term is used in the claim and the Specification than the one Appellant would have us apply. In our view, the totality of the evidence weighs in favor of giving the claim term “download” an ordinary and customary meaning that is broader than the one Appellant submits.

Accordingly, we find that the ordinary and customary meaning that, one of ordinary skill in the art at the time of the invention would give the claim term “download” is the one the dictionaries give; that is, it broadly means transferring a file or data from one computer to another.

Therefore, claim 14 is reasonably broadly construed to be drawn to a system comprising a network server having the capability of providing a web site having audio files available for transfer from one computer to another by web site visitors, wherein one or more of the audio files include an embedded audio message from a sponsor. Given this construction, the subject matter claimed reads on the system disclosed in Wolfe. As the Examiner has shown, and the Appellant has not disputed, Wolfe discloses a network server with one or more audio files available to visitors wherein the audio files are embedded with audio messages from a sponsor. Answer 3. Wolfe's audio files, with the embedded messages, are made available for "streaming" which necessarily requires data to be transferred from one computer to another computer (*i.e.*, audio data is transferred from the transmitting computer to the receiving computer). This is supported by statements made in Wolfe to the effect that audio information is "transmitted" from a CPU over the Internet to subscriber operating PCs. *See e.g.*, Wolfe col. 3, ll. 48-56; *see also* Fig. 1. Wolfe's audio files are therefore "available for download." For this reason, we find that claim 14 covers Wolfe's system.

The Appellant has provided evidence of secondary considerations of non-obviousness. App. Br. 11-12. We do not find them adequate to overcome the *prima facie* case as reasoned above. The Declaration of Rod Underhill, dated February 15, 2008, appears to say that Mr. Underhill was involved with a system for downloading audio files at the time of the invention and was somewhat impressed by the Appellant's effort to have commercials embedded in downloadable audio files. Mr. Underhill appears

to have been curious about the Appellant's effort and speculates that the Appellant's invention may be commercially viable. These are personal subjective observations about the Appellant's invention that provide little or no information about, for example, the commercial success of or the long-felt need for the invention. We do not see in what way these observations would overcome a *prima facie* case of obviousness. The Appellant also cites a commercial website that the Appellant asserts uses the Appellant's ad-sponsored music distribution model. App. Br. 12. Again, the relevance of the existence of such a website for overcoming a *prima facie* case of obviousness is unclear. Moreover, there is no objective evidence on record to support the allegation that the website mentioned implements the Appellant's invention and even if true whether this website is even commercially successful.

Having now considered all the evidence presented by Appellant against obviousness and weighing all the evidence anew, it is our conclusion that the evidence for obviousness greatly outweighs the evidence against obviousness. See *In re Fenton*, 451 F.2d 640, 643 (CCPA 1971) (the court balanced the Patent Office's case against the strength of Appellant's objective evidence of non-obviousness.)

Accordingly, it is our legal conclusion that the subject matter of claim 14 is unpatentable under 35 U.S.C. §103(a) over Wolfe. Because claims 15 and 17-23 stand or fall with claim 14, we reach the same conclusion as to those claims. We will therefore affirm the rejection. However, our reasoning in affirming the rejection is significantly different from that used

by the Examiner. Accordingly, we will denominate the affirmance as a new ground of rejection.

*Claim 16*

Claim 16 calls for the website to calculate royalties based in part on a number of times an audio file is downloaded. The Examiner stated that this is shown in Wolfe at col. 5, ll. 34-37. Answer 4. The Appellant disputes that Wolfe discloses calculating royalties based on a number of times an audio file is downloaded. According to the Appellant, what is disclosed there is calculating royalties based on the number of times an audio file is played. App. Br. 12. However, calculating royalties based on the number of times an audio file is played is disclosed in Wolfe as an “example.” Wolfe’s system also records “the frequency of play and transmission of music” (col. 5, l. 31). Given this, it would have been obvious to one of ordinary skill in the art to calculate royalties based on a number of times an audio file is transmitted. Since we have construed the claim term “download” as meaning transmitting, Wolfe renders obvious the claimed subject matter to one of ordinary skill in the art.

Our reasoning in affirming the rejection of claim 16 depends on reasoning different from that of the Examiner. Accordingly, we will denominate the affirmance as a new ground of rejection.

*Claims 24 and 27-29*

The Appellant argued claims 24 and 27-29 as a group (App. Br. 12-13 and Reply Br. 3-4). We select claim 24 as the representative claim for this



group, and the remaining claims 27-29 stand or fall with claim 24. 37  
C.F.R. § 41.37(c)(1)(vii) (2007).

The Appellant takes issue with the Examiner's taking of Official Notice that "it is well known within the computer industry that . . . incoming data stream files may be transferred to removable storage devices, such as CD-ROMs, smart cards, tapes etc. For example, users have been recording radio and television broadcast onto audio tape for years" (Answer 13). App. Br. 12-13.

We agree with the Examiner. The claimed subject matter is a playback method comprising the steps of downloading to a computer, which, as we have reasonably broadly construed it, reads on Wolfe, and "transferring the audio file to an external playing device that plays the audible advertisement when playing the audio file." As the Examiner has stated, external devices such as videotape recorders that are capable of receiving transferred audio files for playback are notoriously well known. Appellant does not dispute this. (Appellant's argument appears to be focused on *locally* storing a stream of data of the type disclosed in Wolfe). The claimed method would have been obvious because all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions. The combination would have yielded nothing more than predictable results (*i.e.*, playback of downloaded content) to one of ordinary skill in the art at the time of the invention. *See KSR*, 550 U.S. at 417

Finally, in *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273, 96 S.Ct. 1532, 47 L.Ed.2d 784 (1976), the Court derived from the

precedents the conclusion that when a patent “simply arranges old elements with each performing the same function it had been known to perform” and yields no more than one would expect from such an arrangement, the combination is obvious. *Id.*, at 282, 96 S.Ct. 1532.

Accordingly, it is our legal conclusion that the subject matter of claim 24 is unpatentable under 35 U.S.C. §103(a) over Wolfe. Because claims 27-29 stand or fall with claim 24, we reach the same conclusion as to those claims.

Our reasoning in affirming the rejection of claims 24 and 27-29 depends on reasoning different from that of the Examiner. Accordingly, we will denominate the affirmance as a new ground of rejection.

#### *Claims 25 and 26*

The Appellant argued claims 25 and 26 as a group (App. Br. 13-14 and Reply Br. 4). We select claim 25 as the representative claim for this group, and the remaining claim 26 stands or falls with claim 25. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

Claim 25 depends on claim 24 and requires further that the external playing device play the audible advertisement each time it plays the audio file. Both the Examiner and Appellant appear to agree that Wolfe shows an inseparable stream of audio content and advertisement. Assuming this is true, in our view, it necessarily follows that an external device to which such a stream is transferred would play it back in the same inseparable condition.

Accordingly, it is our legal conclusion that the subject matter of claim 25 is unpatentable under 35 U.S.C. §103(a) over Wolfe. Because claim 26 stands or falls with claim 25, we reach the same conclusion as to that claim.

Our reasoning in affirming the rejection of claims 25 and 26 depends on reasoning different from that of the Examiner. Accordingly, we will denominate the affirmance as a new ground of rejection.

*Claims 30, 32, and 33*

The Appellant argued claims 25 and 26 as a group (App. Br. 13-14 and Reply Br. 4). We select claim 25 as the representative claim for this group, and the remaining claim 26 stands or falls with claim 25. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

The arguments raised in challenging this rejection are those that were raised in challenging the rejection of 15, 17-24, and 27-29. App. Br. 14-17. We addressed them above. For the same reasons given supra, we find that the subject matter of claim 30 is unpatentable under 35 U.S.C. §103(a) over Wolfe. Because claims 32 and 33 stand or fall with claim 30, we reach the same conclusion as to those claims.

Our reasoning in affirming the rejection of claims 30, 32, and 33 depend on reasoning different from that of the Examiner. Accordingly, we will denominate the affirmance as a new ground of rejection.

*Claim 31*

The arguments raised in challenging this rejection are those that were raised in challenging the rejection of 16. App. Br. 17-18. We addressed

them above. For the same reasons given *supra*, we find that the subject matter of claim 31 is unpatentable under 35 U.S.C. §103(a) over Wolfe.

Our reasoning in affirming the rejection of claim 31 depends on reasoning different from that of the Examiner. Accordingly, we will denominate the affirmance as a new ground of rejection.

*Claim 34*

Claim 34 depends on claim 30 and adds the step of transmitting the combined file to a second different user to store for later playback.

We have addressed the argument about whether it would have been obvious to provide for a playback method comprising the steps of downloading to a computer, which, as we have reasonably broadly construed it, reads on Wolfe, and transferring the audio file to an external playing device, such as a videotape recorder, that play the combined audio file. See the discussion with respect to the rejection of claims 24 and 27-29. For a similar reason, it would have been obvious to one of ordinary skill in the art over Wolfe and known external devices, such as videotape recorders, to transmit Wolfe's combined audio file to a user to store the combined audio file on an external device for later playback. We find no patentable significance in adding a second user to that method such that, for example, a second external playing device could be used to store and play the combined audio file. It merely duplicates the function of transferring the audio file to a first user having an external device. *Cf. In re Harza*, 274 F.2d 669, 774 (CCPA 1960) ("It is well settled that the mere duplication of parts has no patentable significance unless a new and unexpected result is produced".) In

that regard, the Appellant does not show that the addition of a second different user to store for later playback produces an unexpected result.

Our reasoning in affirming the rejection of claim 34 depends on reasoning different from that of the Examiner. Accordingly, we will denominate the affirmance as a new ground of rejection.

*Claims 35, 36, and 37*

Independent claim 35 (on which claims 36 and 37 depend) adds a step of saving a transmitted downloadable combined audio file to a user computer. The issue here is whether Wolfe shows or would have led one of ordinary skill in the art to *save* a download to a user's *computer*.

The Examiner concedes that Wolfe does not expressly disclose locally storing its streamed audio file. Answer 8. However, according to the Examiner, Wolfe's discussion of a security measure for preventing copying implies that if the security measure is not adopted, the audio file can be copied, an act which requires the file to first be saved. Answer 8. The difficulty with this argument is that copying a file does not necessarily require a file to first be saved on a computer.

The Examiner also argues that "Official Notice is taken that it was old and well known at the time of the invention that incoming data file can be locally stored [e.g.,] on the receiving device's hard drive . . . ." Answer 8. However, the Appellant extensively argues that the type of streaming Wolfe

conducts is incapable of being locally stored. App. Br. 21-22.<sup>3</sup> Appellant has provided adequate information and argument to create on its face a reasonable doubt regarding the circumstances justifying Examiner's Notice that locally storing a streamed audio file is well known to one of ordinary skill in the art. *In re Boon*, 439 F.2d 724, 728 (CCPA 1971). Under this circumstance, it was incumbent on the Examiner to support the Official Notice with evidence. Since that was not done, the record as it now stands does not establish a prima facie case of obviousness for the claimed subject matter.

#### DECISION

The decision of the Examiner to reject claims 14-37 is affirmed-in-part.

We reverse the rejection of claims 35-37.

We affirm the rejection of claims 14-34 but denominate the affirmed rejection of claims 14-34 as new grounds of rejection pursuant to our authority under 37 C.F.R. § 41.50(b).

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)).

---

<sup>3</sup> We should point out that we have not found Appellant's argument with respect to storing a stream of data of the type disclosed in Wolfe on an *external* device to be similarly adequate. See the discussion with respect to claims 24 and 27-29 *supra*.

37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner . . . .
- (2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record . . . .

AFFIRMED-IN-PART; 37 C.F.R. 41.50(b)

mev

KLARQUIST SPARKMAN, LLP  
121 SW SALMON STREET, SUITE 1600  
PORTLAND OR 97204